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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/808,315 02/28/97 KINOSHITA

H 247/PD-5385

MM91/1113  
JOHN P. SCHERLACHER, ESQ.  
HOGAN & HARTSON, L.L.P.  
500 SOUTH GRAND AVENUE, SUITE 1900  
BILTMORE TOWER  
LOS ANGELES CA 90071

EXAMINER

MENEFEE, J

ART UNIT

PAPER NUMBER

2881

DATE MAILED:

11/13/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/808,315

Applicant(s)

KINOSHITA ET AL.

Examiner

James Menefee

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of group I, claims 17 and 20-21 in Paper No. 19 is acknowledged.

***Specification***

The abstract of the disclosure is objected to because it does not describe the invention as now claimed due to the elections and amendments. Correction is required. See MPEP § 608.01(b).

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Kato. Kato describes a sapphire body in which a sharp edge is formed by a working plane and a cleavage plane. The angle between the two planes is shown to be 57.6 degrees (see

abstract, figure 3), which the applicant admits to be less than about 70 degrees.

Regarding the preamble "tool", it is inherent that Kato describes a tool as Kato meets all of the claimed features as described above.

Claims 20 and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Morita. Morita teaches a sapphire monocrystal (col. 3 lines 4-5) having a major face ({11-20} plane a) and a working reference plane ({1-102} plane r) on a peripheral edge of the monocrystal, said reference plane being substantially parallel to a plane R. The reference plane is used as a mark to form a microcrack line for cleaving on the major face (col. 3, lines 58-67). Also, with the angle between the plane R and the reference plane being parallel, this falls into between -10 to 10 degrees.

### ***Response to Arguments***

Applicant's arguments filed 10 March 2000 have been fully considered but they are not persuasive. Applicant made the following arguments:

a. "Setsune does not teach or suggest the amended claim 17, and claim 17 is patentable over Setsune."

b. "The Morita reference does not qualify as prior art against claims 18-21, and these claims are therefore allowable."

Regarding argument a above, the argument is moot as a separate reference Kato is now being used to show lack of novelty of the amended claim.

Regarding argument b above, it is true that the filing of the priority documents overcomes the 35 U.S.C. 102(e) rejection, however the Morita reference has a foreign

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filing date of December 1995 which is before the claimed priority date. Therefore Morita can be used in a 35 U.S.C. 102(a) rejection.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Menefee whose telephone number is (703) 306-5941. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Arroyo can be reached on (703) 308-4782.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JM  
November 9, 2000

  
TERESA M. ARROYO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800